



PATENT
Attorney Docket No. 10222.0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Duane LANGENWALTER)	Group Art Unit: 3679
)	
Application No.: 10/797,410)	Examiner: Michael P. Ferguson
)	
Filed: March 10, 2004)	
)	
For: DECORATIVE FENCING SYSTEM)	Confirmation No.: 4112
)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant submits this Reply to the Examiner's Answer dated March 19, 2008. A Request for Oral Hearing is being filed concurrently with this Reply Brief.

I. ARGUMENT

A. Carlson Does Not Anticipate Claims 1, 2, and 10 under 35 U.S.C. § 102(b)

Claim 1 is an independent claim. For the purpose of this appeal, dependent claims 2 and 10 stand or fall with claim 1.

Claim 1 recites a fencing system comprising, *inter alia*, “a plurality of stakes configured to be driven into the ground, each said stake including a hollow stake sleeve having an internal diameter,” and “a plurality of posts, each said post having a first diameter being smaller than the internal diameter of each said hollow stake sleeve, any one of said posts slidably interchangeably inserting into and being frictionally and removably retained by any one of said stake sleeve.” [Emphasis added].

The claim therefore requires the fencing system to be anchored by stakes driven into the ground, and that “any one of” the posts is configured to be “slidably interchangeably” inserted into, and “frictionally and removably retained by” “any one of” the stake sleeves. For Carlson to anticipate the claim under § 102(b), Carlson must disclose, expressly or inherently, a plurality of stakes, having stake sleeves, driven into the ground, and a plurality of posts, any one of which is slidably inserted into and frictionally retained in any one of the plurality of stake sleeves, the posts being both removable and interchangeable. Carlson fails to anticipate the claim.

1. Carlson does not disclose, expressly or inherently, that the fence anchors are stakes

In his Answer, at page 3, lines 21-23, the Examiner observes that Carlson discloses “a plurality of stakes 5 configured to be driven into the ground, each stake including a hollow stake sleeve having an internal diameter.” The Examiner, however,

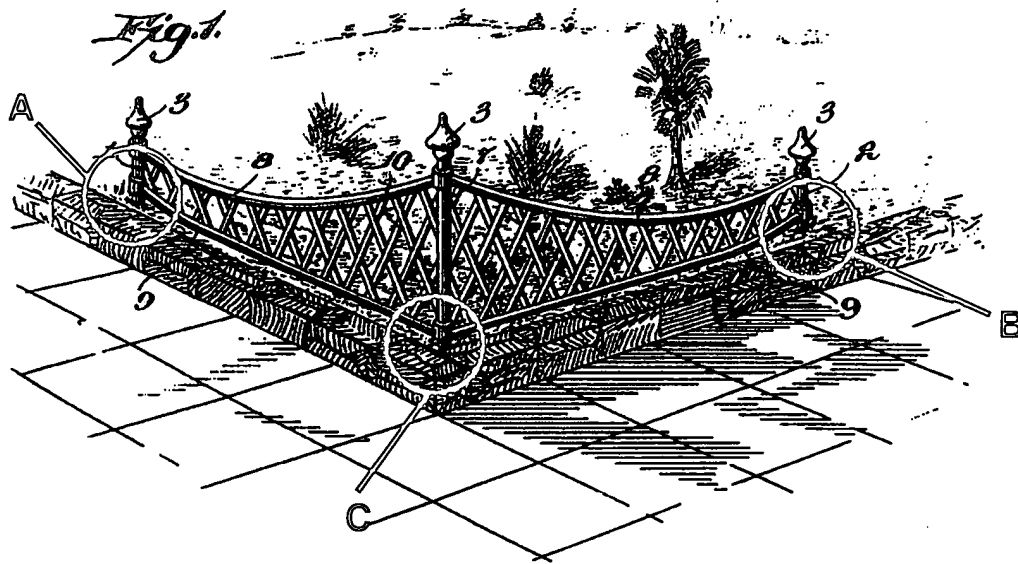
neglects to point out that (i) Carlson also discloses a flat-bottomed anchoring device 6, which is not configured to be driven into the ground; (ii) Carlson does not expressly require the use of one anchoring member or the other; and (iii) Carlson expressly discloses at col. 1, lines 40-45, that either form of anchor device 5 or 6 may be used, as may be deemed most efficient and desirable.

Because Carlson, unlike claim 1, does not expressly require use of a plurality of stakes driven into the ground, such as the anchoring stake 5, the only question is whether Carlson inherently requires use of a plurality of stakes driven into the ground, such as anchoring stake 5. As discussed in Appellant's Appeal Brief, inherency does not embrace mere probability or possibility. Instead, a claim limitation is inherent in a prior art reference only if it is necessarily present in the reference. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002); *Trintec Indus. Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297 (Fed. Cir. 2002); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

In his Answer, the Examiner has not argued that use of a plurality of stakes, configured to be driven into the ground, such as the stake anchor 5, is inherently disclosed in Carlson. Instead, the Examiner states "a plurality of stakes 5 are clearly used together in Fig. 1, since bottom plates of anchor member 6 are clearly not shown and thus such embodiment is not disclosed in Fig. 1." (Emphasis added).

The word "clear" is defined as "easily seen through, transparent, easily visible, plain, free from obscurity or ambiguity, easily understood, unmistakable, free from doubt." Webster's Ninth New Collegiate Dictionary 1984.

Fig. 1 of Carlson, reproduced below, depicts a fence, defining a 90 degree angle, located in a corner of an unnumbered brick or rail wall. Three (3) anchor points are vaguely depicted in Fig. 1, which for purpose of this discussion have been circled and designated as anchor points A, B, and C.



Because of the vague quality of the drawing, anchor points A and B are not “easily visible,” “transparent,” “unmistakable,” or “free from ambiguity” on the issue of whether a stake 5, driven into the ground, or an above-ground anchoring device 6, is used as the anchor. Moreover, anchor point C, as depicted in Fig. 1, is hidden behind the corner of the brick or rail wall, where it cannot be seen at all, so it cannot be determined from Fig. 1 whether anchor point C is a stake 5 or an above-ground anchor 6. Since Fig. 1 of Carlson does not expressly disclose that the anchor points are stakes driven into the ground; the only issue is inherency, and nothing in the disclosure of Carlson necessitates the use of stake 5, driven into the ground.

Instead, Carlson expressly discloses at col. 1, lines 40-44 that “either form of anchoring member 5 or 6 is attached to the lower end [of post 7] thereof as may be deemed most efficient and desirable.”

In summary, contrary to the Examiner’s arguments, Fig. 1 of Carlson does not clearly depict use of a plurality of stakes driven into the ground.

2. Carlson does not expressly or inherently disclose that any one of a plurality of posts are slidably, interchangeably inserted into, and frictionally, removably retained by any one of the stake sleeves

The specification of Carlson is silent on whether any post is slidably, interchangeably inserted into, and frictionally, removably retained by any one of the anchoring points, and slidably, interchangeably insertable into and frictionally, removably retained by any other one of the anchoring points.

The Examiner, in his Answer, at page 4, lines 2-9, asserts that because Carlson discloses an ornament 3 removably, frictionally received in post 1, as shown in Fig. 5, and that because “the cross-sectional view of the engagement between ornament 3 and post 1 is identical to the cross-sectional view of the engagement between post 1 and stake 5, as shown in Fig. 2, it is readily apparent that posts 1 are also removably, frictionally received within stakes 5. Clearly, each of posts 1 and each of stakes 5 are identical and post 1 may be interchangeably inserted into any one of stakes 5.”

This argument again relies on a misuse of the term “clearly,” and also is incorrect, at least for the reasons set forth below.

(a) **Carlson does not disclose that the ornament is removable, or interchangeable**

Carlson does not disclose, expressly or inherently, that any ornament is interchangeably inserted into any post, or that any ornament is frictionally, removably retained by any post. Carlson expressly discloses at lines 35-42 and Figs. 3 and 5 only that ornamental sections 3 “have a stem 4 designed to enter the open end of posts 1 and 2,” but Carlson makes no mention of whether the ornaments are removable from the posts 1 and 2, or interchangeable in any other one of posts 1 and 2.

(b) **Even if the ornament is removable from the post, that does not establish that any one of the posts is slidably, interchangeably insertable into and removably, frictionally retained by any one of the stake sleeves**

Even assuming, for sake of argument only, that Carlson’s ornament 3 is removable from posts 1 and 2, and interchangeable with another post 1 and 2, the dimensions of the openings at the upper end of posts 1 and 2 to receive the ornament 3 are not *ipso facto* identical to the dimensions of openings in stakes 5, to receive the posts, as depicted in Fig. 2. The specification of Carlson does not expressly disclose that these dimensions are the same. In fact, the specification does not disclose any dimensions of any of the different posts and sleeves. Nor are identical dimensions of the openings in the posts and the openings in the stake sleeves a necessary result of the disclosure in the specification, hence precluding both an express disclosure and an inherent disclosure thereof in the specification.

Reliance on the depiction of allegedly equal cross-sectional dimensions in Figs. 2 and 5 is improper. Patent drawings are not drawn to scale. Absent any written description in the specification of quantitative values, arguments based on

measurements of the drawings have little merit. In re Wright, 569 F.2d 1124, 1127 (C.C.P.A. 1977).

Furthermore, in Fig. 5, the extension of a single ornament 3 is narrower and is provided in one opening in a single post 1, indicating at most that at time of assembly an external diameter of an extension on one ornament was smaller than an internal diameter of one opening in one post. However, in order for any one of the posts to be interchangeably insertable into, and frictionally removably retained by any one of the stake sleeves, the external diameter of each post must be smaller than an internal diameter of each stake. Just as there is no express or inherent disclosure in Carlson that an ornament 3 is slidably, interchangeably inserted into any post, or that any ornament 3 is frictionally removably retained by any post, there also is no express or inherent disclosure in Carlson that any post is slidably, interchangeably inserted into any stake sleeve, or that any post is frictionally, removably retained by any stake sleeve.

Even if the Examiner's arguments related to dimensions were correct, therefore, that would not necessarily result in any one of Carlson's posts being slidably interchangeably inserted into and frictionally removably retained by any one of Carlson's stake sleeves. It is equally likely that once the single ornament 3 is inserted into one single post, it is fixed in place, not removable and/or not interchangeable, and it is equally likely that once a single post is inserted into a single stake sleeve, it is fixed in place, and not removable or interchangeable. Hence, Carlson contains neither an express disclosure, nor an inherent disclosure that any one of the posts is slidably,

interchangeably inserted into any one of the stake sleeves, and is frictionally, removably held by any one of the stake sleeves, as recited in the claims.

**(c) The Examiner, not the Applicant speculates
regarding the drawings of Carlson**

At page 13, line 8 - page 14, line 7 of his Answer, the Examiner states that Appellant is speculating about the drawings of Carlson, and that the “drawings are good for that [sic-what] they show.” (Page 14, line 8). Appellant has not speculated with respect to any drawing in Carlson, and concurs that the drawings are good for what they show.

For the reasons discussed above, Fig. 1 of Carlson does not depict a plurality of stakes configured to be inserted into the ground. Ground anchors A and B are unclear because of the quality of the drawing, and ground anchor C is hidden behind a wall. In addition, because the specification states expressly that the ground anchors can be either stakes 5 or above-ground anchors 6, it cannot be ascertained that ground anchors A, B, and C, and particularly ground anchor C, are stakes. Fig. 1 of Carlson thus does not disclose, expressly or inherently, “a plurality of stakes configured to be driven into the ground, each said stake having a hollow stake sleeve having an internal diameter,” as recited in claim 1.

The drawings of Carlson further do not disclose that any one of the posts is slidably interchangeably insertable into any one of the stake sleeves, or frictionally removably retained by any one of the stake sleeves. Carlson discloses only a single post attached to a single stake 5 or attached to a single above ground anchoring device 6, and expressly discloses that either the stakes or the above-ground anchoring devices can be used, as desirable. It is the Examiner, not Appellant, who speculates that the

posts are slidably, interchangeably inserted to the anchors, and frictionally, removably retained by the anchors. The Examiner's ubiquitous misuse of the term "clearly" cannot change the fact that the claim elements of slidability, interchangeability, and removability of any one of the posts with respect to any one of the stake sleeves are not disclosed by Carlson.

Moreover, as stated above, the Examiner's argument that Carlson's ornaments are removable from the posts, and hence Carlson's posts are removable from the stakes, establishes nothing. Carlson only discloses a single ornament attached to a single post, not a slidably, interchangeably, inserted, and removable ornament, and even if, for the sake of argument only, the ornament was removable from the post and interchangeable with another ornament in another post, it does not automatically follow that any one of the posts is removable slidably inserted into, removable from, and interchangeable with, any one of the stake sleeves.

For all of the above reasons, the Examiner has failed to establish that all of the elements of independent claim 1 are disclosed, expressly or inherently in Carlson. Carlson, therefore, fails to anticipate claim 1 under § 102(b).

Claims 2 and 10 depend from claim 1, incorporate all of the elements of claim 1, and at least for this reason, also are not anticipated by Carlson under 102(b).

**B. Claims 11-15 are not unpatentable under 35 U.S.C.
§ 103(a) over Carlson in view of Gibbs**

For the purpose of this appeal, dependent claims 11-15 stand or fall with claim 1.

Claims 11-15 all depend from claim 1, and incorporate the features of claim 1 discussed above. At pages 5-6 of his Answer, the Examiner has not argued, and has no basis upon which argue, that Gibbs discloses the above-discussed features absent

from Carlson. Gibbs also discloses vertical posts 12, but includes no disclosure of how these posts 12 are fixed to the ground, if at all. Gibbs does not disclose that any one of the posts are slidably interchangeably inserted into, and frictionally and removably retained by any one of a plurality of stake sleeves. Instead, the Examiner relies on Gibbs only for the purpose of disclosing claimed features related to material of construction and welding.

At least because the combination of Carlson and Gibbs fails to disclose or suggest “a plurality of posts, each said post having a first diameter being smaller than the internal diameters of each said hollow stakes sleeve, any one of said posts, slidably interchangeably inserting into, and being frictionally and removably retained by any one of said stake sleeves,” this combination of references fails to set forth a *prima facie* case of obviousness of claims 11-15. See *In re Rouffet*, 174 F.3d 1350 (Fed. Cir. 1998).

C. Claims 1-10 and 16 are not unpatentable under 35 U.S.C. § 103(a) over Ravert in view of Carlson

Claim 16, similar to claim 1, recites, among other things, a stake configured to be driven into the ground, including a stake sleeve, and a cylindrical post “frictionally and removably retained by said stake sleeve.”

At page 6, line 16 of his Answer, the Examiner states that Ravert teaches a plurality of footings 12 “configured to be fastened to the ground.” This statement is misleading.

Ravert teaches a miniature fence “for ornamental purposes for use in connection with Christmas trees, etc.”, lines 9-11. The footings or “peripheral flanges” 12 are “adapted to rest upon the floor or other support,” lines 61-62, and to be bolted to the

floor with screws 14, lines 69, 102-104, and Fig. 4. The footings of Ravert are not configured to be fastened to the ground.

Claim 16, in contrast, require “at least one wedge-shaped stake configured to be driven into the ground . . .,” not fastened to the floor with screws as depicted in Ravert.

The Examiner states at page 7, line 22 - page 8, line 2, of his Answer, that it would be obvious to substitute stakes 5, as taught by Carlson, with the bolt-held flanges 12 of Ravert, based on the assumption that flanges and stakes are “functional equivalents for securely fastening a fence post to the ground,” citing *In re Fout*, 675 F.2d 297, 301 (C.C.P.A. 1982).

In re Fout is inapposite. *In re Fout* involved a claim reciting a method for separating caffeine from coffee, using a process similar to one disclosed in the prior art for separating caffeine from oil, and the Court held that the processes were functionally equivalent. The mere fact that two elements (in this case, an indoor fence anchor disclosed by Ravert, and an outdoor fence anchor disclosed by Carlson, may both be used to anchor fences is insufficient alone to establish them as functional equivalents. See In re Ruff, 45 C.C.P.A. 1037, 1048 (C.C.P.A 1958). In the present case, the Examiner argues that it would be functionally equivalent to substitute Carlson’s stakes 5 for Ravert’s flanges 12 and bolts 14. Such a substitution would result in driving a sharpened stake through a floor, on which the Ravert fence is configured to be mounted, an absurd result. Likewise, a screw 14, of the type depicted to secure the flange 12 of Ravert to a floor, would be insufficient to hold a post to the ground, and the flanges 12 are not configured to be driven into the ground.

For these reasons, the Carlson stakes, and the Ravert flanges 12 and screws 14, are not interchangeable or functionally equivalent.

Moreover, even if for sake of argument only, Carlson's stakes 5 were substituted for the flanges 12 and screws 14 of Ravert, that still would not create a *prima facie* case of obviousness of the claim under § 103(a). For all of the reasons discussed above, Carlson does not disclose or suggest that any post is slidably, interchangeably inserted into any stake sleeve, or frictionally, removably retained by any stake sleeve. Ravert also contains no disclosure or suggestion whatsoever of this feature of the claims. To the contrary, Ravert discloses in Fig. 4 and lines 60-65, that flanges 12 are secured to posts B with bolts 10, a disclosure which teaches a person of ordinary skill in the art to fix the posts to the anchors, not to have any post slidably, frictionally, removably, and interchangeably mounted to any anchor.

A combination of these two references, viewed in their entirety, therefore, teaches away from the claimed combination of elements. There is no suggestion to combine if a reference teaches away from its combination with another reference. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *In re Graselli*, 713 F.2d 731, 743 (Fed. Cir. 1983); *TecAir, Inc. v. Denso Mfg., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999).

At page 7, lines 9 et. seq., and again at page 10, line 17- page 11, line 10 of his Answer, the Examiner repeats his arguments related to Carlson's teachings of stakes and posts, all of which fail for the same reasons stated above with respect to the § 102(b) rejection of claim 1.

At page 8, lines 14-21 of his Answer, the Examiner contends that Ravert discloses removable and interchangeable attachment of fence units and gate units to the posts. This teaching of Ravert is immaterial; removability of fence units from posts does not suggest, and the Examiner has not so argued, that any one of the posts are slidably, interchangeably inserted into, and frictionally, removably retained by any one of the stake sleeves. A teaching of any one of the posts slidably, interchangeably inserted into, and frictionally, removably retained by any one of the stake sleeves, only can be found in the disclosure and claims of the application on appeal in the present application. The Examiner's position, therefore, constitutes impermissible hindsight, not a legal conclusion reached on the basis of facts gleaned from the prior art. M.P.E.P. § 2142.

D. Claims 1-15 are not unpatentable over Ravert in view of Carlson and further in view of Gibbs

The Examiner, in his Answer, again cites Gibbs for teaching material of construction and welding features.

Gibbs, however, cannot cure the deficiencies of Carlson and Ravert, *i.e.*, the complete absence of a teaching of a plurality of stakes with stake sleeves, driven into the ground, with a plurality of posts, each post having a diameter smaller than a diameter of the stake sleeves, any one of said posts slidably interchangeably inserting into, and being frictionally and removably retained by, any one of said stake sleeves."

Absent an express or inherent disclosure, or even a suggestion, of at least these elements, which are incorporated into claims 11-15, the combination of Ravert, Carlson, and Gibbs, fails to render these claims obvious under § 103(a).

E. Declaration of Paul Gossling

Applicant submitted, during prosecution of this case, and again in its Appeal Brief, a Declaration of Mr. Paul L. Gossling. Mr. Gossling is the President of the assignee of the application on appeal (Gossling Decl., ¶ 2), and as such is in a unique position to know relevant facts related to a commercial product corresponding to the apparatus recited in the claims on appeal. In his Declaration, Mr. Gossling states that the apparatus (a decorative fencing system) is embodied in a commercial product sold by the assignee under the name “Empire Fence.” (Gossling Decl. ¶ 3.)

Mr. Gossling describes the features of the Empire Fence in terms which paraphrase the claims on appeal, particularly the features of a plurality of stakes configured to be driven into the ground, and posts, any one of which is slidably interchangeably insertable into, and frictionally, removably retained by any one of the stakes, as discussed above. The chart below demonstrates how Mr. Gossling’s description of the Empire Fence establishes a nexus with the claims on appeal, with a particular emphasis on the features of stakes with stake sleeves, configured to be driven into the ground, and interchangeable posts configured to be inserted into the stake sleeves, such posts being held by friction in the stake sleeves, while still being removable. Because the posts can be removed from the stake sleeves, the posts are interchangeable.

Gossling description Decl. ¶ 5	Claim 1
Features of the Empire Fence . . . include:	A fencing system comprising . . .
a number of stakes, having internal	a plurality of stakes configured to be driven

sleeves, configured to be driven into the ground	into the ground, each said stake including a hollow stake sleeve having an internal diameter;
a number of posts configured to be inserted into the internal sleeves of the stakes, and to be held in place in the internal sleeves by friction, <u>while still being removable</u> Furthermore, the inner diameters of the internal sleeves of the stakes are slightly larger than the diameters of the posts. For these reasons, the posts . . . are interchangeable, and a wide variety of fence configurations can be assembled by the customer. After assembling one fence configuration, the customers can easily disassemble it, simply by removing the structural fencing components from the posts, and removing the posts from the internal sleeves of the stakes. Due to the interchangeability of the components, the customer can assemble a completely different fence configuration without removing the stakes from the ground.	a plurality of posts, each said post having a first diameter being smaller than the internal diameter of each said hollow stake sleeve, any one of said posts slidably, interchangeably inserting into and being frictionally and removably retained by any one of said stake sleeves; and a plurality of structural fencing components, each of said fencing component including at least one post attachment collar disposed on an edge thereof, said post attachment collar having an annular opening therethrough, said annular opening having a second diameter larger than said first diameter of each post, any one of said fencing components slidably, pivotably, and interchangeably attaching to any one of said posts, to thereby connect adjacent structural fencing components to each other while allowing said fencing components to be rotationally adjusted relative to said posts

Mr. Gossling also listed three (3) years worth of sales figures for the Empire Fence. In the product's first year on the market (2004), sales exceeded \$575,000. In the product's second year (2005), sales exceeded \$3M. Sales in 2006, at the time Mr. Gossling signed the Declaration, exceeded \$7M.

Mr. Gossling provided a nexus between this dramatic commercial success and the features of the claims. Indeed, Mr. Gossling used language from the claims themselves: "the surprising commercial success of the Empire Fence is due to its versatility, ease of assembly, ease of disassembly, and interchangeability of the posts . . . , in order to easily and quickly assemble different fence configurations." This

sentence, in combination with the portions of the Declaration discussed above, provides a nexus between the easily-visible commercial success, and the claim features discussed in detail through this Reply Brief, *i.e.*, a plurality of stakes having internal stake sleeves, configured to be driven into the ground, and a plurality of posts, any one of which is configured to be slidably, removably and interchangeably inserted into any one of the stake sleeves. The removability (*i.e.*, “disassembly”) and interchangeability of the posts with respect to any one of the stake sleeves, which is neither taught nor suggested by any of the references cited by the Examiner, also per the testimony of the President of the assignee, is responsible for the commercial success of the claimed fence product.

In his Answer, the Examiner acknowledges the Gossling Declaration, but dismisses it as allegedly non-persuasive. On the issue of commercial success, the Examiner argues that the Declaration fails to provide evidence of market share or the true source of commercial success, *e.g.*, advertising, affordability, or novelty of the invention. The Examiner, however, provides no evidence that the commercial success of the product is not related to the features of the claimed apparatus; he provides only argument related to the Declaration’s alleged shortcomings.

Mr. Gossling, however, as discussed above, has stated that the marketed product embodies features of the claims, and that these claimed features caused the commercial success. When the marketed product embodies the claimed features, as is the case here, and is coextensive with them, a nexus between the claimed features and the commercial success is presumed. *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000).

The Gossling Declaration should be considered as additional, secondary indicia of the nonobviousness of the claims on appeal.

II. CONCLUSION


For all of the above reasons, Applicant respectfully submits that claims 1-16 are allowable, and the rejections should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 19, 2008

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